

REMARKS

In response to the Office Action mailed March 15, 2006, Applicants amend the application and seek reconsideration thereof. In this response, Applicants amend claims 11-20. No new claims are added and no claims are cancelled. Accordingly, claims 1-30 are pending.

I. Claims Rejected Under 35 U.S.C. § 101

Claim 11 was rejected under 35 U.S.C. § 101 as directing to non-statutory intangible embodiments. Accordingly, Applicants have amended claim 11 to conform to 35 U.S.C. §101.

Applicants respectfully submit that claim 11, as amended, satisfies the statutory subject matter requirements of 35 U.S.C § 101 and respectfully request the withdrawal of the rejection of the claim under § 101.

II. Claims Rejected Under 35 U.S.C. § 103

Claims 1 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,404,494 issued to Garney (hereinafter "Garney") in view of U.S. Patent No. 5,935,228 issued to Shinomura (hereinafter "Shinomura"). Applicants respectfully disagree with the rejection because the combination is improperly motivated.

To establish a *prima facie* case of obviousness, each element of a claim must be taught or suggested by the combined references. In particular, the M.P.E.P. § 2143.01

states that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination . . . Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'"

The Examiner recites in the Office Action that it would have been obvious to one of ordinary skill in this art at the time of the invention by Applicants to reclaim resources as taught by Shinomura in the method of Garney for the purpose of allowing resources to be re-allocated to newly added peripherals.

Garney discloses a method and apparatus for a computer system having dynamic device driver configuration for removable system resources. (See Garney, col. 4, lines 28-30). Garney recites that device driver cards may be added to and removed from the system without fear that the amount of system memory set aside for device driver stubs will prove inadequate. (See Garney, col. 8, lines 1-15). Hence, there is no need for reclaiming resources in the memory because by allocating enough space per slot in computer system memory to contain the largest permitted card device driver stub, one using the invention in Garney can ensure that there will always be enough computer system memory to contain every device driver stub required by the system at a given time. (See Garney, col. 5, lines 7-20). Thus, it is not an object of the invention in Garney to reclaim resources because there are a fixed number of driver stubs that can be used by the system at any given time, and the memory allocated for each is

predetermined at bootstrap initialization. (See Garney, col. 7, line 66-col. 8, line 3).

Further, once a card is removed, the driver stub memory area for the removed card will automatically be replaced by driver stub memory for a new card placed in the same card slot. (See Garney, col. 18, lines 27-30). Therefore, Garney teaches away from reclaiming resources.

Shinomura discloses a method for automatically enabling a PC card whereby, when a PC card that can be driven only by a DOS/Windows 3.x device driver is inserted, the PC card is enabled by that device driver, and whereby, when a PC card is inserted that can be driven by a Windows 95 native mode device driver, the PC card is enabled by that device driver. (See Shinomura, abstract). When a PC card is removed, a Socket Service ascertains whether the PC card is controlled by a 32-bit Card Service or a 16-bit Card Service. The Socket Service then notifies the corresponding Card Service of the card removal event, and as a result, the Card Service notifies a corresponding client device driver of the removal event. Upon receiving the notice, the client device driver releases the system resources allocated for the PC card and disables the PC card. (See Shinomura, col. 17, lines 1-20).

However, there is no motivation to combine Garney and Shinomura, because there is no indication in Garney that a device driver card utilizes any resources that would need to be freed once the card is removed. Applicants have been unable to discern any part of Garney that teaches that the device driver cards rely on other system

resources, and therefore, there would be no need to recapture anything allocated from such other system resources.

Therefore, the cited references cannot be properly combined to teach or suggest each of the elements of claim 1, and Applicants respectfully request the withdrawal of the rejection of claim 1 under 35 U.S.C. § 103(a).

In regard to claim 10, this claim depends from independent claim 1 and incorporates the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 1, Applicants assert that claim 10 is not obvious over Garney in view of Shinomura. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 10 is requested.

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Garney in view of Shinomura, and further in view of U.S. Patent No. 4,135,240 issued to Ritchie hereinafter ("Ritchie"). Claim 11 includes limitations similar to claim 1. Whereas claim 1 recites a method, claim 11 recites a computer program product in a recordable-type media.

Ritchie does not cure the deficiencies found with respect to Garney and Shinomura. The Examiner has not relied upon and Applicants have been unable to discern any part of Ritchie that would provide a basis for combining Garney and Shinomura to teach or suggest each of the elements of claim 11. Thus, at least for the reasons above, as well as those mentioned in regard to claim 1, Applicants assert that claim 11 is not obvious over Garney in view of Shinomura, and further in view of

Ritchie. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 11 is requested.

In regard to claim 20, this claim depends from independent claim 11 and incorporates the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 11, Applicants assert that claim 20 is not obvious over Garney in view of Shinomura, and further in view of Ritchie. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 20 is requested.

III. Allowable Subject Matter

Applicants note with appreciation that the Examiner has indicated that claims 2-9 and 12-19 contain allowable subject matter. The Examiner has indicated that claims 2-9 and 12-19 are objected to as being dependent upon rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

Claims 2-9 depend either directly or indirectly from independent claim 1, thereby including all the limitations of claim 1. Claims 12-19 depend either directly or indirectly from independent claim 11, thereby including all the limitations of claim 11. Therefore, at least for the reasons mentioned above in regard to claims 1 and 11, Applicants respectfully submit that claims 2-9 and 12-19, respectively, are in condition for allowance. Accordingly, Applicants respectfully request the withdrawal of the objections.

Further, Examiner has indicated that claims 21-30 contain allowable subject matter. Applicants respectfully thank the Examiner for this allowance.


CONCLUSION

Claims 1-30 are currently pending. In view of the foregoing amendments and remarks, Applicants respectfully submit that the pending claims are in condition for allowance. Applicants respectfully request reconsideration of the application and allowance of the pending claims. If the Examiner determines the prompt allowance of these claims could be facilitated by a telephone conference, the Examiner is invited to contact attorney Thomas M. Coester at (310) 207-3800 ext. 765.

Respectfully submitted,

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Dated: June 9, 2006

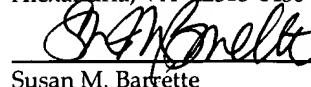


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6/9/06
June 9, 2006